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In re Application of
Howard M. Kingston, Marc R.
Anderson, Ye Han
Application No. 10/004,627
Filed: December 4, 2001
Attorney Docket No. M-15307 US

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: DECISION GRANTING PETITIONS
: UNDER § 1.48(a) and § 1.183
:
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This is a decision on the "RENEWED PETITION UNDER 37 C.F.R. 1.183 AND 37 C.F.R. 1.48(A)", filed May 4, 2005, to waive the requirement under § 1.48(a)(3) for execution of the declaration by all of the actual inventors.

The petition under 37 CFR 1.183 is **GRANTED**.

The petition under 37 CFR 1.48(a) is **GRANTED**.

The above-identified application was filed on December 4, 2001. A properly executed declaration identifying sole inventor Howard Kingston was filed on February 12, 2002, in response to a Notice to File Missing Parts mailed December 31, 2001. On April 16, 2004, applicants filed a request under § 1.48(a) to amend the inventorship to add joint inventors Marc R. Anderson and Ye Han. Accompanying the petition were statements from added inventors Anderson and Han stating that the inventorship error occurred without deceptive intention; and a declaration executed by Anderson and Han.

37 CFR 1.48(a) requires:

(1) A request to correct the inventorship that sets forth the desired inventorship change;

(2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the inventorship error occurred without deceptive intention on his or her part;

(3) An oath or declaration by the actual inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43, or § 1.47;

(4) The processing fee set forth in § 1.17(i); and

(5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

In the April 16, 2004 petition, petitioner satisfied requirements (1), (2), and (4). The petition specifically requested the addition of inventors Anderson and Han. Petitioner paid the processing fee. However, the petition did not satisfy requirement (5). The petition included a statement signed by the "Director and Chief Technical Officer of Metars, Inc.", who states that the assignee consents to the change in inventorship.¹ A "Director and Chief Technical Officer" is not presumed to have authority to sign on behalf of the assignee corporation.

Accordingly, the petition was dismissed in a decision mailed on April 7, 2005. Petitioner was instructed to submit a statement from an officer - e.g. President, Vice-President, Secretary, Treasurer, or Chief Executive Officer, or supply a statement from the person signing stating that he or she is authorized to sign on behalf of the corporation.²

On renewed petition, petitioner has submitted a written consent of the assignee signed by Robert C. McDonald, Vice President and Chief Technical Officer of Metars, Inc.

Under 37 C.F.R. § 1.183, any requirement of the regulations, which is not a requirement of the statutes, may be waived by the Commissioner's designee in an extraordinary situation, when justice so requires. Waiver of the requirement is appropriate in this instance. The facts of the record do not present uncertainty as to this correction of inventorship. The assignee has given consent to the requested correction. Petitioner has shown that Kingston has been given the opportunity to sign the declaration adding the joint inventors, but refuses to do so.

Accordingly, the newly executed declaration filed on July 19, 2004 will be entered, despite the fact that the requirement set forth in 37 CFR 1.48(a)(3) that all the inventors sign a reexecuted oath or declaration has not been satisfied.

The application is being forwarded to Group Art Unit 2883 for processing.

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3207.

cliff Congo

Cliff Congo
Petitions Attorney
Office of Petitions

¹ Office records show the assignment is recorded at Reel/Frame 012827/0593.

² See MPEP 409.03(b).